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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,434	01/26/2004	Donald E. Black	4012	3611
29356	7590	11/14/2005	EXAMINER	
JERRY SEMER 617 CROGHAN ST. FREMONT, OH 43420			CHAMBERS, MICHAEL S	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PAtch

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/766,434	BLACK, DONALD E.
	<b>Examiner</b> Mike Chambers	<b>Art Unit</b> 3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 October 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Terminal Disclaimer***

The terminal disclaimer filed on 10/15/05 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 6,682,447 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1,3-5,9,11,13-15, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bickel et al (20020193187). Bickel discloses the elements of claim 1, however it fails to clearly disclose the use of a plurality of weights. The specification provides no unanticipated or surprising results from using a plurality of weights, therefore this is considered a design choice. It would have been obvious to one of ordinary skill in the art at the time of the invention to have selected any one of several equivalent means to provide weights in the bat based on cost and design considerations.

As to claims 3 and 13 : Bickel discloses a bore of consistent diameter (fig 1).

As to claims 9 and 19 : Bickel discloses a plastic material (fig 1, paragraph 022).

As to claims 4,5,14 and 15 : See claim 1 rejection. The specification provides no unanticipated or surprising results from using a plurality of weight members of varying weights and sizes, therefore these are considered design choices.

As to claim 11: See claim 1 rejection. Outer cap is considered item "A".

Also,

Claims 1-8, 11-18, and 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owen et al (3116926) in view of Pomila (4682773). Owen discloses the elements of claim 1, however it fails to clearly disclose the use of a bat with a uniform outer diameter. Pomila discloses the use of a bat with a uniform outer diameter (fig 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to have selected the bat shape disclosed in Pomila with the apparatus of Owen the in order to reduce material costs and provide a distinguishable bat for training.

As to claims 2 and 12 : Owen discloses positionable weight members (fig 2).

As to claims 3 and 13 : Owen discloses a bore of consistent diameter (fig 2).

As to claims 4,5,14 and 15 : See claim 1 rejection. The specification provides no unanticipated or surprising results from using a plurality of weight members of varying weights and sizes, therefore these are considered design choices.

As to claims 6,7, 16 and 17 : Owen discloses a threaded flanged inner cap (fig 2). The specification provides no unanticipated or surprising results from using a threaded flanged inner cap , therefore it is considered a design choice.

As to claims 8 and 18: Owen discloses a spring (fig 2).

As to claims 10 and 20 : Nelson discloses an aluminum tube (3:19-22).

As to claim 11: See claim 1 rejection.

Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited art above, and further in view of Blum (4644630). The specification provides no unexpected results in using a plastic material ( abstract ). The use of plastic is old in the art. It would have been obvious to one of ordinary skill in the art to have selected the material of Blum in order to produce an inexpensive and durable article for sale.

Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited art above, and further in view of Merritt ( 4600193 ). The specification provides no unexpected results in using an aluminum material ( 2:8-12 ). The use of aluminum is old in the art. It would have been obvious to one of ordinary skill in the art to have selected the material of Merritt in order to produce an inexpensive and durable article for sale.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 571-272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

4600193\*4644630\*3116926\*4682773\*200201931 Michael Chambers  
87 Examiner  
Art Unit 3711

November 8, 2005

*Gene R*

EUGENE KIM  
PRIMARY EXAMINER